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09/853,567	05/11/2001	Junichiro Sakata	7217/64552	6317

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EXAMINER

SELLERS, DANIEL R

ART UNIT PAPER NUMBER

2644

DATE MAILED: 04/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/853,567

Applicant(s)

SAKATA, JUNICHIRO

Examiner

Daniel R. Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 August 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/26/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-24, drawn to a style of audio playback, classified in class 700, subclass 94.
  - II. Claims 25-30, drawn to audio processing for playback and a graphical user interface for an audio program, classified in class 700, subclass 94.
  - III. Claims 31-65, drawn to playback control of an audio device, classified in class 700, subclass 94.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I, II, and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as use as an automated disc jockey for broadcast audio, invention II has separate utility such as controlling signal processing in an audio playback device, and invention III has separate utility such as controlling the sequence of playback. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and the search required for Group I, II, or III is not required for the other respective groups, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Jay Maioli on April 18, 2005 a provisional election was made with traverse to prosecute the invention of group III, claims 31-65.

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Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-30 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

5. Claims 62 and 64 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Regarding claims 62 and 64, wherein they both depend from claim 61, they both recite a limitation already recited in claim 61. In particular, the phrase "displaying at least content that is played back... are mutually distinguished from other content." is claimed in claims 61, and again in the dependent claims 62 and 64.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

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Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 31-37, 44-50, and 57-60 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Adatia et al., U.S. Patent Application Publication 2003/0112262 (hereinafter Adatia).

8. Regarding claim 31, see Adatia

*A playback apparatus for playing back contents by sequentially switching the contents in accordance with a play list in which the contents to be played back are recorded, the playback apparatus comprising:*

*display means for producing a display such that displays showing the contents in the play list are arranged so that the contents become continuous in sequence in a playback sequence from a content that is currently being played back at least from one of a display of an operation element for instructing a starting of playback and a display of an operation element for instructing a stopping of playback; (Page 2, paragraph 0036, Page 5, paragraph 0071, and Figs. 3 and 17) and*

*switching means for switching the arrangement of the displays showing the contents in response to the switching of the playback of the contents. (Page 3, paragraphs 0054 and 0055)*

Adatia teaches these features in a playback apparatus.

9. Regarding claim 32, the further limitation of claim 31, see Adatia

*... wherein a display showing the content whose playback has been terminated is placed at the end of the arrangement. (Page 10, section titled File Input and Playback Mode Buttons, lines 3-5)*

Adatia teaches the functional equivalent of placing content at the end of the arrangement. Adatia teaches the use of a repeat, or loop, function, wherein the playlist starts from the beginning when the last piece of content in the playlist finishes.

10. Regarding claim 33, the further limitation of claim 31, see

*... wherein a display showing said content is the name of said content. (Page 5, paragraph 0071)*

Adatia teaches this feature.

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11. Regarding claim 34, the further limitation of claim 31, see Adatia

... wherein said content is audio data. (Page 1, paragraph 0028, lines 1-2)

Adatia teaches that the content is audio.

12. Regarding claim 35, see

*A playback apparatus for playing back contents by sequentially switching the contents in accordance with a play list in which the contents to be played back are recorded, said playback apparatus comprising:*

*display forming means for forming a display showing a piece of content that is currently being played back in a predetermined area of a display section; (Page 2, paragraph 0033, lines 6-7)*

*display means for producing a display in such a way that the displays showing the contents of the play list are arranged so that the play list contents become continuous in sequence in a playback sequence with respect to the display showing the content that is currently being played back; (Page 3, paragraph 0054, lines 1-4) and*

*switching means for switching the arrangement of the display showing the content which is currently being played back and the display showing the contents of the play list. (Page 2, paragraph 0037 and Page 3, paragraph 0055, lines 1-2)*

Adatia teaches these features in a playback device.

13. Regarding claim 36, the further limitation of claim 35, see the preceding argument with respect to claim 32. Adatia teaches equivalent features.

14. Regarding claim 37, the further limitation of claim 35, see the preceding argument with respect to claim 33. Adatia teaches a playback device wherein a display shows the name of a piece of content.

15. Regarding claim 44, see the preceding argument with respect to claim 31.

Adatia teaches these features of the method.

16. Regarding claim 45, the further limitation of claim 44, see the preceding argument with respect to claim 32. Adatia teaches an equivalent feature.

17. Regarding claim 46, the further limitation of claim 44, see the preceding argument with respect to claim 33. Adatia teaches this feature.

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18. Regarding claim 47, the further limitation of claim 44, see the preceding argument with respect to claim 34. Adatia teaches audio content.

19. Regarding claim 48, see the preceding argument with respect to claim 35. Adatia teaches these features.

20. Regarding claim 49, the further limitation of claim 48, see the preceding argument with respect to claim 32. Adatia teaches an equivalent feature.

21. Regarding claim 50, the further limitation of claim 48, see the preceding argument with respect to claim 33. Adatia teaches this feature.

22. Regarding claim 57, see the preceding argument with respect to claim 31. Adatia teaches a computer readable medium with these features.

23. Regarding claim 58, the further limitation of claim 57, see the preceding argument with respect to claim 32. Adatia teaches an equivalent feature.

24. Regarding claim 59, see the preceding argument with respect to claim 35. Adatia teaches a computer readable medium with these features.

25. Regarding claim 60, the further limitation of claim 59, see the preceding argument with respect to claim 32. Adatia teaches an equivalent feature.

26. Claims 38- 43, 51-56, and 61-65 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Katinsky et al., U.S. Patent No. 6,452,609 (hereinafter Katinsky).

27. Regarding claim 38, see Katinsky

*A playback apparatus for playing back contents in sequence in accordance with a play list in which said contents to be played back are recorded, said playback apparatus comprising:*

*display means for displaying a plurality of play lists; (Col. 1, lines 64-67)*

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*playback means for, when the playback of one piece of content of one play list from among said plurality of play lists is terminated, playing back one piece of content of another play list; (Col. 5, lines 49-52) and*

*display means for displaying at least the content which is currently being played back and the content to be played back next in such a way that the contents can be mutually distinguished from the other content. (Col. 5, lines 12-14).*

Katinsky teaches a playback apparatus with multiple playlists. It is inherent in the teachings of Katinsky that the beginning of a first song in a subsequent playlist follows the termination of the last song in a first playlist.

28. Regarding claim 39, the further limitation of claim 38, see Katinsky

*... further comprising:*

*first display means for producing a display such that displays showing the contents of the play lists are arranged for each play list so that the contents become continuous in sequence in a playback sequence from content that is currently played back at least one of from a display of an operation element for instructing the starting of playback and from a display of an operation element for instructing a stopping of playback; and (Fig. 1 and 6B)*

*second display means for displaying at least the content that is currently being played back and the content to be subsequently played back such that the contents are mutually distinguished from other content. (Col. 6, lines 6-18)*

Katinsky teaches these features in a playback apparatus.

29. Regarding claim 40, the further limitation of claim 39, see Katinsky

*... wherein the display showing the content whose playback has been terminated is placed at the end of said corresponding arrangement. (Col. 8, lines 15-16)*

Katinsky teaches the feature of placing content at the end of an arrangement after it has been terminated.

30. Regarding claim 41, the further limitation of claim 38, see Katinsky

*... further comprising:*

*display forming means for forming a display showing the content which is currently being played back in a predetermined area of a display section; (Fig. 1, unit 16)*

*display means for producing a display in such a way that the displays showing the contents of said play lists are arranged for each play list so that the contents become continuous in sequence in a playback sequence with respect to the display showing said content which is currently being played back; and (Fig. 1, unit 14 and Fig 6B)*



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*display means for displaying at least the content which is currently being played back and the content to be played back next in such a way that the contents can be mutually distinguished from the other content.* (Col. 5, lines 12-14, Col. 13, lines 55-63, and Fig. 15, steps 1540 and 1544)

Katinsky teaches these features in a playback apparatus.

31. Regarding claim 42, the further limitation of claim 41, see the preceding argument with respect to claim 40. Katinsky teaches this feature.

32. Regarding claim 43, the further limitation of claim 38, see Katinsky

*... wherein the content is audio data and the playback results of the continuous contents are mixed and output.* (Col. 3, lines 50-52)

Katinsky does not explicitly teach that the contents are mixed, however it is inherent that audio players have a shuffle, or random, play mode. It is inherent that a random playback in an audio causes the inputted audio to become mixed and then output.

33. Regarding claim 51, see the preceding argument with respect to claim 38.

Katinsky teaches these features.

34. Regarding claim 52, the further limitation of claim 51, see the preceding argument with respect to claim 41. Katinsky teaches these features.

35. Regarding claim 53, the further limitation of claim 52, see the preceding argument with respect to claim 40. Katinsky teaches these features.

36. Regarding claim 54, the further limitation of claim 51, see the preceding argument with respect to claim 41. Katinsky teaches these features.

37. Regarding claim 55, the further limitation of claim 54, see the preceding argument with respect to claim 40. Katinsky teaches these features.

38. Regarding claim 56, the further limitation of claim 51, see the preceding argument with respect to claim 43. Katinsky teaches these features.

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39. Regarding claim 61, see the preceding argument with respect to claim 38.

Katinsky teaches a computer readable medium with these features.

40. Regarding claim 62, the further limitation of claim 61, see the preceding argument with respect to claim 41. Katinsky teaches these features.

41. Regarding claim 63, the further limitation of claim 62, see the preceding argument with respect to claim 40. Katinsky teaches these features.

42. Regarding claim 64, the further limitation of claim 61, see the preceding argument with respect to claim 41. Katinsky teaches these features.

43. Regarding claim 65, the further limitation of claim 64, see the preceding argument with respect to claim 40. Katinsky teaches these features.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel R. Sellers whose telephone number is 571-272-7528. The examiner can normally be reached on Monday to Friday, 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DRS



**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**